

Application No. 10/654,661
Response to Office Action of November 03, 2004

REMARKS/ARGUMENTS

Claims 1-105 are pending. Favorable reconsideration is respectfully requested in light of the Remarks below.

At the outset, Applicants thank Examiner Acquah for his helpful explanations of the rejection and suggestions to overcome the same.

The rejection of Claims 1-64 under the judicially created doctrine of obviousness double patenting over pending Claims 1-29 of copending US patent Application No. 10/384,075(attached hereto as Exhibit A) is traversed below.

Examiner Acquah so kindly indicated that the rejection is provisional. Applicants kindly direct the Office's attention to the PAIR system indicating that a Petition to Withdraw from Issue has been granted for Copending US patent Application No. 10/384,075. Therefore, prosecution of Claims 1-29 of copending US patent Application No. 10/384,075 remains open. Accordingly, Applicants kindly request that the rejection be held in abeyance until at least one set of claims in the present case or Claims 1-29 of copending US patent Application No. 10/384,075 issue in a US patent.

The rejection of Claims 65-99 under 35 U.S.C. § 101 over pending Claims 1-29 of copending US patent Application No. 10/384,075(attached hereto as Exhibit A) is traversed below.

Application No. 10/654,661
Response to Office Action of November 03, 2004

At page 800-20 of the MPEP, MPEP § 804(II)(A) states:

"A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine."

The present case is very similar to the above-mentioned case in which "identicalness" is lacking, thereby proscribing a statutory double patenting rejection. In the present case, Claims 1-29 of copending US patent Application No. 10/384,075(attached hereto as Exhibit A) recite that, in part, a phenolic compound be present, where phenol constitutes at least 25 wt% of the phenolic compounds. In the present application, Claim 65-99 recite, in part that a phenolic compound that is at least trifunctional with respect to reactivity be present, where the phenolic compound that is at least trifunctional with respect to reactivity constitutes at least 25 wt% of all phenolic compounds. While phenol may be the phenolic compound that is at least trifunctional with respect to reactivity constitutes at least 25 wt% of all phenolic compounds, the present application further states other chemicals may be the phenolic compound that is at least trifunctional with respect to reactivity. Examples of such are, in part, those recited from lines 1-9, at page 29 of the present specification.

In view of the above, the phenolic compound that is at least trifunctional with respect to reactivity may include phenol, but is not restricted to only phenol in the present

Application No. 10/654,661
Response to Office Action of November 03, 2004

application. Accordingly, Claims 65-99 of the present invention are not, per se, "identical" to Claims 1-29 of copending US patent Application No. 10/384,075(attached hereto as Exhibit A) as required to sustain a provisional statutory double patenting rejection under 35 U.S.C. § 101. Accordingly, withdrawal of this ground of rejection is respectfully requested.

The rejections of Claims 28,39,41-42, 44, 68, 70, 72, and 74, under 35 U.S.C. § 112, second paragraph, and the objection of Claims 74-75 under 37 C.F.R. § 1.75(c) are traversed below.

A dependent claim includes any and all claim limitations included on the base claims from which it is dependent. In the present application, the following relationships occur:

| <u>Dependent Claim</u> | <u>Base Claim(s)</u> |
|------------------------|----------------------|
| 28 | 1 |
| 39 | 1 |
| 41 | 1 |
| 42 | 1,2 |
| 44 | 1,3 |
| 68 | 65 |
| 70 | 65 |
| 72 | 65 |
| 74 | 65 |
| 75 | 65 |

In the case of Claims 28, 39, and 41, all of which ultimately depend from Claim 1. In this case, Claim 1 requires the presence of fatty acids, aldehyde, and phenolic compounds, all of which are required to be present in the claimed process according to Claim 1. Each of Claims 28, 39, and 41, provides an alternative embodiment of the claimed invention as

Application No. 10/654,661
Response to Office Action of November 03, 2004

pertains to upper limits of the relative amounts of fatty acids, aldehyde, and phenolic compounds. Since Claims 28, 39, and 41 depend from Claim 1, each include all of the claim limitations of Claim 1 which, in part requires at least the presence of fatty acids, aldehyde, and phenolic compounds. Accordingly, although the "up to" language in each of Claims 28, 39, and 41 provides an upper limit, this limit can not possibly be indefinite due to an interpretation that the limit includes zero because the claim limitations of Claim 1 (from which all of Claims 28, 39, and 41 depend) clearly requires that the range more narrowly defined in each of Claims 28, 39, and 41 does not include zero.

Likewise, Claim 42 depends from Claim 2 and requires an upper limit on an amount of polyol utilizing "up to" language. Claim 2 requires the presence of a polyol. Accordingly, although the "up to" language in Claim 42 provides an upper limit, this limit can not possibly be indefinite due to an interpretation that the limit includes zero because the claim limitations of Claim 2 (from which Claim 42 depends) clearly requires that the range more narrowly defined in Claim 42 does not include zero.

Still likewise, Claim 44 depends from Claim 3 and requires an upper limit on an amount of α,β -olefinically unsaturated carbonyl compound utilizing "up to" language. Claim 3 requires the presence of a α,β -olefinically unsaturated carbonyl compound. Accordingly, although the "up to" language in Claim 44 provides an upper limit, this limit can not possibly be indefinite due to an interpretation that the limit includes zero because the claim limitations of Claim 3 (from which Claim 44 depends) clearly requires that the range more narrowly defined in Claim 44 does not include zero.

In the case of Claims 68, 70, 72, and 74, all of which depend from Claim 65, these claims utilize "up to" language to specify an upper limit and/or a narrower embodiment

Application No. 10/654,661
Response to Office Action of November 03, 2004

of a reactant in terms of wt% of the reactants. Claim 65 requires the presence of rosin, fatty acid, aldehyde, and phenolic compound(s), all of which are required to be present in the claimed process according to Claim 65. Since Claims 68, 70, 72, and 74 include any and all claim limitations of Claim 65 by virtue of dependency and Claim 65 requires the presence of all of rosin, fatty acid, aldehyde, and phenolic compound(s), Claims 68, 70, 72, and 74 can not possibly be indefinite due to an interpretation that the range defined therein includes zero because the claim limitations of Claim 65 (from which Claims 68, 70, 72, and 74 depend) clearly requires that the range more narrowly defined in Claims 68, 70, 72, and 74 does not include zero.

In the case of Claims 74 and 75, it should be noted that the claim limitation therein sets an upper limit on the presence of phenolic compound(s) based upon *the wt% of the reactants*, where Claim 65 specifies that phenolic compound(s) be present and that a phenolic compound that is at least trifunctional with respect to reactivity constitutes at least 25 wt% of *all phenolic compounds*. A wt% based upon that of *all phenolic compounds* and a wt% based upon *the reactants* are two completely defined measures that are not indefinite, yet are different measurements limiting the claims in different manners that are not conflicting. Accordingly, Claims 74 and 75 further limit the claimed invention because the wt% recited therein are based upon a completely different measurement, e.g. a wt% based upon *the reactants* vs. a wt% based upon that of *all phenolic compounds*.

In light of all of the above, Applicants respectfully request withdrawal of the above-mentioned rejection and objection.

The rejection of Claims 1-65 and 100-105 under 35 U.S.C. §102(b) over Bender et al. (US'932) is traversed below.

Application No. 10/654,661
Response to Office Action of November 03, 2004

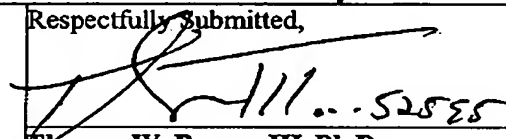
To sustain a rejection under 35 U.S.C. §102(b), each and every claim limitation must be disclosed by US'932. Further, to demonstrate inherency, it is not enough to show that an inherent property *may* occur each and every time, but there must be a concrete demonstration or reasoning set forth by the Office that such property does, in fact, occur each and every time. The Office Action dated November 11, 2004, merely provides two conclusion statements lacking any reference whatsoever to specific disclosures within US'932 that demonstrate US'932 discloses each and every limitation of Claims 1-65 and 100-105, much less the specific basis within US'932 that sets out a reasonable expectation that "claimed" physical characteristics would occur each and every time.

In light of the above, the Applicants have not been given an appropriate rejection on the merits. The only recitation is a general reference to "Columns 2-13" of US'932. This is completely inappropriate because Applicants can not possibly have the foresight to know exactly which disclosures within US'932 that the Office relies upon for its grounds for the rejection and inherency rejection. How can Applicants examine the merits of the rejection in the absence of such specific recitations and explanations of inherency reasoning? The burden can not possibly shift to the Applicants in this case because the burden is indefinable in light of the lack of specific reference therein US'932. Accordingly, Applicants respectfully request that if the Office maintains the rejection, the Office issue a second Non-Final Office Action that includes the specific references to US'932 that serves as the basis of its rejection and inherency position so that Applicants are provided a fair opportunity to analyze its foundation and respond accordingly. Otherwise, Applicants respectfully request withdrawal of the rejection.

Application No. 10/654,661
Response to Office Action of November 03, 2004

In addition, Applicants note that the Office has rejected Claim 65 which specifies that the phenolic compound that is at least trifunctional with respect to reactivity constitutes at least 25 wt% of all phenolic compounds. It appears as if there is absolutely no contemplation of such an invention by US'932, especially in the present environment where the Office has failed to present the reasons for the rejection and a reasonable case for inherency. Accordingly, applicants kindly request that this rejection be explained more thoroughly in a non-Final Office action so as to provide Applicants an opportunity to respond to the merits. Otherwise, Applicants respectfully request withdrawal of the rejection.

Applicants respectfully submit that the present application is now in condition for allowance. Favorable reconsideration is respectfully requested. Should anything further be required to place this application in condition for allowance, the Examiner is requested to contact below-signed by telephone.

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